TLC

UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/663,891	09/18/2000	Robert Chojnacki	N0064US	4137

37583 7590 08/23/2006

NAVTEQ NORTH AMERICA, LLC
222 MERCHANDISE MART
SUITE 900, PATENT DEPT.
CHICAGO, IL 60654

EXAMINER	
KHOSHNOODI, NADIA	

ART UNIT	PAPER NUMBER
2137	

DATE MAILED: 08/23/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/663,891	CHOJNACKI, ROBERT	
	Examiner	Art Unit	
	Nadia Khoshnoodi	2137	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *05 June 2006*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-6 and 8-39* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-6 and 8-39* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *18 September 2000* is/are: a)☒ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Response to Amendment

Applicant's arguments/amendments with respect to amended claims 1, 8, 10, & 24 and previously presented claims 2-6, 9, 11-23, & 25-39 filed 6/5/2006 have been fully considered and therefore the claims are rejected under new grounds. The Examiner would like to point out that this action is made final (See MPEP 706.07a).

Claim Objections

Claim 5 is objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form. Due to the amendments made, the limitation "encrypting said first portion" no longer further limits the independent claim from which it depends since the first portion is already encrypted in amended claim 1.

Claim Rejections - 35 USC § 103

I. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

II. Claims 1, 3-6 and 8-9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Shear et al., United States Pub. No. 2001/0042043.

As per claim 1:

Shear et al. teach a method for on-line mass distribution of data products to end users, the method comprising: maintaining an encrypted first portion of each of said data products at a first location (par. 200, lines 6-16), maintaining an unencrypted second portion of each of said data products at a second location (par. 199, lines 1-10); for each of said end users, confirming the end user's entitlement to one of said data products (par. 199, lines 11-27); obtaining an encrypted first portion of said one of said data products from said first location and an unencrypted second portion of said one of said data products from said second location (par. 200); decrypting said encrypted first portion (par. 200); wherein said end user is located at said second location (par. 199), and providing first portion and second portion to said user, wherein the first portion of said data product comprises critical data that enables a program executed on a computing platform to use said data product including both the first portion and the second portion together for an intended purpose (par. 200. lines 17-18).

Not explicitly disclosed is combining said decrypted first portion of said one of said data products and said unencrypted second portion of said one of said data products.
However, in another embodiment, Shear et al. teach that the device must use the usage rights for the content as sent from the provider as well as the usage rights for the content as stored on the DVD itself in order to allow full use of the content. Therefore, it would have been obvious to a person in the art at the time the invention was made to modify the method in one embodiment as disclosed in Shear et al. to combine each of the usage rights as determined by both entities/locations in order to ensure that only the correct level of access to the data product is allowed. This modification would have been obvious because a person having ordinary skill in

the art, at the time the invention was made, would have been motivated to do so since Shear et al. suggest that in order to allow for interoperability between the location of where the content is provided from and the actual DVD, it is important to determine the access rights based on a combination of what the two entities will allow in par. 326.

As per claim 3:

Shear et al. substantially teach the method of claim 1. Furthermore, Shear et al. teach wherein said data products include digital copies of movies (par. 203).

As per claim 4:

Shear et al. substantially teach the method of claim 1. Furthermore, Shear et al. teach wherein said data products include digital copies of musical songs (par. 204).

As per claim 5:

Shear et al. substantially teach the method, as applied to claim 1 above. Furthermore, Shear et al. teach the method further comprising the step of: encrypting said first portion of each of said data products (par. 200, line 6-16).

As per claim 6:

Shear et al. substantially teach the method, as applied to claim 1 above. Not explicitly disclosed is further comprising the step of prior to the step of combining, encrypting said first portion of one of said data products. However, Shear et al. teach that it is possible to maintain the rights in a secure and protected fashion on the disc. Therefore, it would have been obvious to a person in the art at the time the invention was made to modify the method in one embodiment as disclosed in Shear et al. encrypt the user rights before combining them at the second location so that the user has no access to that information as it should be kept confidential. This

modification would have been obvious because a person having ordinary skill in the art, at the time the invention was made, would have been motivated to do so since Shear et al. suggest that the content usage may be metered by the provider to ensure that the rights are not being exceeded, thus these rights should remain confidential so that the user may not find and alter the usage rights when stored in par. 200, lines 6-27 and par. 289.

As per claim 8:

Shear et al. substantially teach a system for secure on-line mass distribution of data products to end users comprising: an entity at a first location having associated therewith copies of first portions of a plurality of data products (par. 200, lines 6-16); a plurality of data distribution terminals at a plurality of locations different from said first location, each of said data distribution terminals has stored thereon copies of second portions of said plurality of data products (par. 199, lines 1-10); a communications system that provides for exchange of data between the entity and said plurality of data distribution terminals (par. 200, lines 6-16), and a data distribution program that provides copies of said data products to those end users who are entitled to have said copies thereof (par. 199, lines 11-27); and where the data product is provided at the data distribution terminal and said end user is located at said location of said one of said plurality of data distribution terminals (par. 199) .

Not explicitly disclosed is wherein said data distribution program provides a copy of a data product by combining a copy of the first portion of said data product obtained from said authorization server with a copy of the second portion of said data product obtained from one of said plurality of data distribution terminals. However, in another embodiment, Shear et al. teach that the device must use the usage rights for the content as sent from the provider as well as the

usage rights for the content as stored on the DVD itself in order to allow full use of the content. Therefore, it would have been obvious to a person in the art at the time the invention was made to modify the method in one embodiment as disclosed in Shear et al. to combine each of the usage rights as determined by both entities/locations in order to ensure that only the correct level of access to the data product is allowed. This modification would have been obvious because a person having ordinary skill in the art, at the time the invention was made, would have been motivated to do so since Shear et al. suggest that in order to allow for interoperability between the location of where the content is provided from and the actual DVD, it is important to determine the access rights based on a combination of what the two entities will allow in par. 326.

Also not explicitly disclosed is an "authorization server" as the entity in that embodiment. However, in another embodiment, Shear et al. teach that an authority server may be incorporated into this scheme in order to check users' entitlements to the data products. Therefore, it would have been obvious to a person in the art at the time the invention was made to modify the method disclosed in Shear et al. to use an authorization server to hold the first portion of the plurality of data products and to ensure that the users' entitlements to the data are kept in tact. This modification would have been obvious because a person having ordinary skill in the art, at the time the invention was made, would have been motivated to do so since it is suggested by Shear et al. in par. 336.

As per claim 9:

Shear et al. substantially teach the system, as applied to claim 8 above. Furthermore, Shear et al. teach wherein said authorization server also has associated therewith an authorization

database containing data indicating entitlement by said end users to copies of said data products (par. 200).

III. Claim 2 is rejected under 35 U.S.C. 103(a) as being unpatentable over Shear et al., United States Pub. No. 2001/0042043 as applied to claim 1 above, and further in view of Porter et al., United States Patent No. 5,845,067

As per claim 2:

Shear et al. substantially teach the method, as applied to claim 1 above. Not explicitly disclosed is the method, wherein said data products include geographic databases. However, Porter et al. teaches that a document can be any information stored as files in a file system, which can equate to the information contained by a geographic database. Therefore, it would have been obvious to a person in the art at the time the invention was made to modify the method disclosed in Shear et al. for the data product to include files of geographical information stored in a file system, which is equivalent to a database. This modification would have been obvious because a person having ordinary skill in the art, at the time the invention was made, would have been motivated to do so since it is suggested by Porter et al. in col. 7, lines 26-32.

IV. Claims 10-22, and 24-38 are rejected under 35 U.S.C. 103(a) as being unpatentable over Shear et al., United States Pub. No. 2001/0042043 and further in view of Ginter et al., United States Patent No. 6,237,786.

As per claims 10 and 24:

Shear et al. substantially teach a system/method comprising, in combination: a first entity maintaining the first portion of the data product at a first location (par. 200, lines 6-16); a second entity maintaining the second portion of the data product at a second location different from said

first location (par. 199, lines 1-10); a first set of logic executable by the first entity to encrypt the first portion so as to produce an encrypted first portion that can be decrypted using a first decryption key, wherein the first entity sends the encrypted first portion via a telecommunications link to the second entity (par. 200); and wherein the first portion of said data product comprises critical data that enables a program executed on a computing platform to use said data product including both the first portion and the second portion together for an intended purpose (par. 200. lines 17-18).

Not explicitly disclosed is a second set of logic executable by the second entity, upon receipt of the encrypted first portion, to record onto the storage medium the encrypted first portion and the second portion wherein an end user of the data product is location at said second location where the encrypted first potion and the second portion are recorded onto the storage medium. However, in another embodiment, Shear et al. teach that the device must use the usage rights for the content as sent from the provider as well as the usage rights for the content as stored on the DVD itself in order to allow full use of the content. Therefore, it would have been obvious to a person in the art at the time the invention was made to modify the method in one embodiment as disclosed in Shear et al. to store each of the usage rights as determined by both entities/locations in order to ensure that only the correct level of access to the data product is allowed. This modification would have been obvious because a person having ordinary skill in the art, at the time the invention was made, would have been motivated to do so since Shear et al. suggest that in order to allow for interoperability between the location of where the content is provided from and the actual DVD, it is important to determine the access rights based on a

combination of what the two entities will allow and to store that information for metering capabilities by the provider in par. 326.

Also not explicitly disclosed is the third entity gaining access to the first decryption key in order to access the data product. However, Ginter et al. teach that in order for a third party, or any party for that matter, to gain access to the data product they must first have the appropriate decryption key. Therefore, it would have been obvious to a person in the art at the time the invention was made to modify the method disclosed in Shear et al. for a third entity to gain access to the first decryption key in order to access the data product. This modification would have been obvious because a person having ordinary skill in the art, at the time the invention was made, would have been motivated to do so since it is suggested by Ginter et al. in col. 131, lines 18-44.

As per claims 11 and 25:

Shear al. and Ginter et al. substantially teach the method/system as applied to claims 10 and 24. Furthermore, Ginter et al. teach the method/system wherein the first entity sends to the second entity, together with the encrypted first portion, an encrypted authorization key that can be decrypted using a second decryption key so as to reveal verification information indicative of an entity authorized to access the data product, and wherein the second set of logic is further executable to record onto the storage medium the encrypted authorization key (col. 14, lines 21-43 and col. 22, lines 13-45).

As per claims 12 and 26:

Shear et al. and Ginter et al. substantially teach the method/system as applied to claims 11 and 25. Furthermore, Ginter et al. teach the method/system wherein the second decryption key is derived as a function of an environmental parameter (col. 22, lines 13-45).

As per claims 13 and 27:

Shear et al. and Ginter et al. substantially teach the method/system as applied to claims 12 and 26. Furthermore, Ginter et al. teach the method/system wherein the environmental parameter comprises an identification code associated with the entity authorized to access the data product (col. 22, lines 13-45).

As per claims 14 and 28:

Shear et al. and Ginter et al. substantially teach the method/system as applied to claims 11 and 27. Furthermore, Ginter et al. teach the method/system wherein the third entity generating the second decryption key as the function of the identification code; the third entity using the second decryption key to decrypt the encrypted authorization key and to thereby gain access to the verification information; and the third entity using the verification information to validate storage of the data product (col. 131, lines 18-44).

As per claims 15 and 29:

Shear et al. and Ginter et al. substantially teach the method/system as applied to claims 11 and 25. Furthermore, Ginter et al. teach the method/system wherein a third set of logic executable by a third entity to decrypt the encrypted authorization information, to thereby gain access to verification information, and to compare at least a portion of the verification information to predetermined information associated with the third entity so as to determine whether the third entity is authorized to gain access to the data product (col. 131, lines 18-67).

As per claims 16 and 31:

Shear et al. and Ginter et al. substantially teach the method/system as applied to claims 15 and 30. Furthermore, Ginter et al. teach the method/system wherein the predetermined information associated with the third entity comprises an identification code (col. 131, lines 40-44).

As per claims 17 and 30:

Shear et al. and Ginter et al. substantially teach the method/system as applied to claims 10 and 29. Furthermore, Ginter et al. teach the method/system wherein the first entity sends to the second entity, together with the encrypted first portion, an encrypted authorization key that can be decrypted using a second decryption key so as to reveal verification information indicative of an entity authorized to access the data product (col. 14, lines 21-43 and col. 22, lines 13-45).

As per claims 18 and 33:

Shear et al. and Ginter et al. substantially teach the method/system as applied to claims 17 and 32. Furthermore, Ginter et al. teach the method/system wherein the second decryption key is derived as a function of an environmental parameter (col. 22, lines 13-25).

As per claims 19 and 34:

Shear et al. and Ginter et al. substantially teach the method/system as applied to claims 18 and 33. Furthermore, Ginter et al. teach the method/system wherein the environmental parameter comprises an identification code associated with the entity authorized to store the data product (col. 22, lines 13-25).

As per claims 20 and 35:

Shear et al. and Ginter et al. substantially teach the method/system as applied to claims 11 and 34. Furthermore, Ginter et al. teach the method/system wherein the third entity generating the second decryption key as the function of the identification code; the third entity using the second decryption key to decrypt the encrypted authorization key and to thereby gain access to the verification information; and the third entity using the verification information to validate storage of the data product (col. 104, line 25 – col. 106, line 15).

As per claims 21 and 37:

Shear et al. and Ginter et al. substantially teach the method/system as applied to claims 11 and 36. Furthermore, Ginter et al. teach the method/system wherein a third set of logic executable by a third entity to decrypt the encrypted authorization information, to thereby gain access to verification information, and to compare at least a portion of the verification information to predetermined information associated with the storage medium so as to determine whether the storage medium is authorized to gain access to store the data product (col. 78, lines 8-58).

As per claims 22 and 38:

Shear et al. and Ginter et al. substantially teach the method/system as applied to claims 21 and 37. Furthermore, Ginter et al. teach the method/system wherein the predetermined information associated with the storage medium comprises and identification code (col. 22, lines 13-45).

As per claim 32:

Shear et al. and Ginter et al. substantially teach the method as applied to claim 24. Furthermore, Ginter et al. teach the method further comprising sending to the second entity,

together with the encrypted first portion, an encrypted authorization key that can be decrypted using a second decryption key so as to reveal verification information indicative of an entity authorized to store the data product (col. 14, lines 21-43 and col. 22, lines 13-45).

As per claim 36:

Shear et al. and Ginter et al. substantially teach the method as applied to claim 32. Furthermore, Ginter et al. teach the method further comprising the third entity using the second decryption key to decrypt the encrypted authorization key and to thereby gain access to the verification information; and the third entity using the verification information tot validate storage of the data product (col. 104, line 25 – col. 106, line 15).

V. Claims 23 and 39 are rejected under 35 U.S.C. 103(a) as being unpatentable over Shear et al., United States Pub. No. 2001/0042043 and Ginter et al., United States Patent No. 6,237,786 as applied to claims 10 and 24 above, and further in view of Ahrens et al., United States Patent No. 5,951,620.

As per claims 23 and 39:

Shear et al. and Ginter et al. substantially teach the method/system as applied to claims 10 and 24. Not explicitly disclosed is the method/system wherein the third entity comprises a navigation system. However, Ahrens et al. teach the use of a navigation system. Therefore, it would have been obvious to a person in the art at the time the invention was made to modify the method disclosed in Shear et al. for the third entity to be a navigation system. This modification would have been obvious because a person having ordinary skill in the art, at the time the invention was made, would have been motivated to do so since it is suggested by Ahrens et al. in col. 7, lines 29-44.

**References Cited, Not Used*

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

1. US Patent No. 6,308,179
2. US Patent No. 5,917,908
3. US Patent No. 6,204,774
4. US Patent No. 6,297,891
5. US Patent No. 6,615,349
6. US Pub. No. 2001/0032088
7. US Pub. No. 2004/0039741

The above references have been cited because they are relevant due to the manner in which the invention has been claimed.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Nadia Khoshnoodi whose telephone number is (571) 272-3825. The examiner can normally be reached on M-F: 8:00-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Emmanuel Moise can be reached on (571) 272-3865. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Nadia Khoshnoodi
Examiner
Art Unit 2137
8/21/2006

NK

EMMANUEL L. MOISE
SUPERVISORY PATENT EXAMINER